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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/071,732

02/07/2002

Alexander Gelbman

VTW-007

2975

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7590

05/21/2004

LAHIVE & COCKFIELD, LLP.
28 STATE STREET
BOSTON, MA 02109

EXAMINER

CHOW, DOON Y

ART UNIT

PAPER NUMBER

2675

9

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,732

Applicant(s)

GELBMAN, ALEXANDER

Examiner

Dennis-Doon Chow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 09/393,553. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are broader than the claims of copending Application ('553).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 09/760,363. Although the conflicting claims are not identical, they are

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not patentably distinct from each other because the present claims are broader than the claims of copending Application ('363).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

4. Claim 49 recites the limitation "the RFID layer" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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6. Claims 1-6, 9-18, 21-25, 27-30, 33-45 and 48 are rejected under 35

U.S.C. 102(e) as being anticipated by Comiskey et al. (6639578).

Comiskey discloses an electronic display label system suitable for displaying information, the system comprising: a flexible display having a bi-stable non-volatile imaging material; one or more power antennas (Col. 14, lines 10-34); a remote activator module in electronic communication with the electronic label (Figs. 2 and 6); a processor for determining the information to be display by the display assembly; a storage element for storing instruction to executed by the processor; a radio transducer; color display regions; and a power source including the power antennas, a battery, a thin film battery (col. 15, line 62), solar cell, and rechargeable storage means. Comiskey further discloses display label system can be used in a supermarket (col. 15, lines line 1).

7. Claims 46-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Comiskey et al. (6473072).

Comiskey discloses an electronic labeling system for displaying information, comprising: a stacked electronic label including a layer of electronic ink disposed over a first electrode (Fig. 1); and an activator module comprising a second electrode (Fig. 2) having a polarity opposition the first electrode for controlling pixels in the display layer.

Claim Rejections - 35 USC § 103

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 7-8, 19-20, 26, 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comiskey et al.

Regarding to claims 7-8 and 31-32, Comiskey further disclose any other electromagnetic signals can be used (col. 4, lines 50-51). Therefore, a well known inductive power and capacitive coupling obviously can be used in Comiskey's system instead of the radio signal.

Regarding to claims 19-20, it is a matter of obvious design choice make the thickness of the electronic label between 100 and 2000 microns because this does not present any unexpected result.

Regarding to claim 26, Comiskey teaches microcapsules (col. 4, line 33), but not size of the microcapsules. However, it is a matter of obvious design choice to make the diameter of the microcapsules between 5-200 micron and the diameter of the charge particles between .001 and .2 of the diameter of the microcapsules because this does not present any unexpected result.

10. Claims 46-47 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comiskey et al. ('578) in view of Comiskey et al. ('072).

Comiskey ('578) discloses an electronic display label system suitable for displaying information, the system comprising: a flexible display having a bi-stable non-volatile imaging material; one or more radio antennas (Col. 14, lines 10-34); and a remote activator module in electronic communication with the electronic label (Figs. 2 and 6).

Comiskey ('578) differs from the claims in that Comiskey does not disclose a first electrode has a polarity opposite a second electrode.

Comiskey ('072), in the same display field, disclose a display comprising a first electrode has a polarity opposite a second electrode.

In light of Comiskey ('072), it would have been obvious to one ordinary skill in the art to substitute the display of Comiskey ('072) for the display of Comiskey ('578) because the display of Comiskey ('072) allows the user to hand write image information on the display.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis-Doon Chow whose telephone number is 703-305-4398. The examiner can normally be reached on 8:30-6:00, Alternate Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Saras can be reached on 703-305-9720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Chow
May 15, 2004



DENNIS-DOON CHOW
PRIMARY EXAMINER